

REMARKS

The Office Action of February 7, 2008, has been received and carefully considered. The Examiner has repeated the rejections from the previous Office Action dated September 14, 2007.

Applicant would like to thank Examiner Clark and Examiner Flood for the in-person interview of May 29, 2008. During the interview, the undersigned attorney discussed the features of Applicant's method in view of the Oura et al. reference. The undersigned attorney stressed that Oura has a washing step, described in col. 3, lines 5-39, where the nut cake is washed to remove the odor. It was pointed out to the Examiners that in that particular step, Oura teaches that the aqueous, or ethanolic suspension created in the washing step, is discarded, and the solids are retained, then dried and ground, or subjected to further heating. The undersigned attorney further pointed out that the discarded solution probably contained the majority of the saponins of interest to Applicants. Moreover, the solids retained by Oura et al., which are the nut cake seed husks and related plant matter, are discarded in Applicant's method.

The undersigned attorney explained to the Examiners that, in contrast to the Oura method, Applicants' claimed process extracts saponins from the nut cake by mixing it with a large volume of heated aqueous alkali solution, and the solids are then filtered from the retained liquid, and discarded. The retained aqueous solution is then concentrated and the saponins are isolated from this concentrate. The fact that the nut cake solids are not the product of interest in Applicant's process was again stressed in the discussion with the Examiner.

During the interview the undersigned attorney and Examiners Flood and Clark discussed amendments to claim 1 to further clarify and define that which Applicant considers to be the invention. Specifically, it was proposed that Applicant amend claim 1 to direct the claims to further delineate the actual method steps of obtaining saponins via incubation in an alkaline medium, and yielding an extract containing saponins. Support for this amendment can be found throughout the specification, particularly at page 3, lines 15-19; page 6, lines 9-29; page 7, lines 14-28; page 8, lines 1-30; page 9, lines 5-12, and examples 3 and 6. No new matter has been added by this amendment.

In addition, during the interview, the Examiners suggested including a transitional phrase "consisting essentially

of" instead of "comprising" before reciting the steps of the process. Applicant has considered this suggestion, but has declined to make this amendment for the following reasons. First, the phrase "consisting essentially of" is primarily used in the context of composition claims, not process or method claims, rendering its meaning more ambiguous, and therefore it should be avoided. According to U.S. case law, in the context of a process claim, when used as a modifier of method steps, the phrase "consisting essentially of" means that it renders the claim open only for the inclusion of steps which do not materially affect the basic and novel characteristics of the claimed method. See, Ex parte Klaus-Jurgen Hoffman and Otto Ruger, 12 U.S.P.Q.2d 1061 (BPAI 1989). Again, this is somewhat ambiguous in the context of process steps. Nevertheless, it is Applicant's view that this phrase is unduly limiting to Applicant's claimed extraction process. This is particularly true when there has been no prior art presented, which specifically teaches extracting saponins from shea butter tree waste in any manner close to what is taught by Applicant, and as such, Applicant deserves the broadest claim supported by the specification and teachings in the art.

Rejection under 35 U.S.C. §103(a)

The Examiner maintained rejection claims 1, 2 and 4-8 under 35 U.S.C. §103(a) as unpatentable over Oura et al., in view of Noller and Vogel et al. for the reasons set forth in the previous Office Action.

Applicant has now amended claim 1 to direct the claims to a method of extracting saponins from butter cake meal. The claim was also amended to more clearly define the individual process steps of how Applicant performs an aqueous or ethanolic extraction of the nut cake, and removes the nut cake solids from the remaining process, followed by enriching the mixture in the desired saponins. Applicant's claimed process is clearly distinct from the method of making a food coloring agent taught in Oura et al., as shown in this table comparing the two processes.

Process Step	Applicant Process	Oura Process
1	1 part nut cake to 4-30 parts water	Add nut cake to water or ethanol soln
2	Add alkali to soln so that pH>7 and mix	soak nut cake for period of time

3	Heat 15-95°C for 10 min to 5 hrs	<u>Decant</u> wash soln and <u>discard</u> , keep nut cake solids
4	Filter off soln and retain, <u>discard</u> nut cake solids	Heat nut cake solids to dryness and grind to powder
5	Add acid or enzymes to further enrich aqueous extract with sapogenins	Add small amount acid or base to powder and heat powder further to achieve desired color and dry

In view of Applicant's amended claim 1, Applicant submits that the Examiner cannot establish a *prima facie* case of obviousness with regard to claims 1, 2 and 4-8, because Oura et al., in view of Noller and Vogel et al., do not teach each and every step of Applicant's amended process of producing an aqueous extract enriched in saponins. As such, Applicant respectfully requests withdrawal of this rejection.

It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present

application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

JACOBSON HOLMAN PLLC



Joseph G. Contrera
Registration No. 44,628

400 Seventh Street, N.W.
Washington, D.C. 20004-2201
(202) 638-6666
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